

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CLAUDE VAILLANCOURT, GHYSLAIN BORDELEAU,
CAROLINE CHARBONNEAU, and JEAN-PIERRE BOYER

Appeal No. 2004-1016
Application No. 10/174,567

ON BRIEF

Before PAK, OWENS, and JEFFREY SMITH, Administrative Patent Judges.

PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 1 through 15, which are all of the claims pending in the above-identified application.

APPEALED SUBJECT MATTER

Claims 1, 4 and 9 are representative of the subject matter on appeal and read as follows:

1. An adjustable air vent for a vehicle comprising:

a stationary grill adapted to be mounted to the vehicle, the stationary grill having at least one air aperture and an engaging surface; and

a movable grill adapted to be movably mounted with respect to the stationary grill, the movable grill having at least one air aperture and an engaging surface adapted to engage the engaging surface of the stationary grill, the movable grill movable with respect to the stationary grill from an open position where the at least one aperture of the stationary grill is aligned with the at least one aperture of the moveable grill to allow air to flow therethrough to a closed position, where the at least one aperture of the stationary grill is not aligned with the at least one aperture of the moveable grill to reduce the flow of air through the vent, the movable grill including at least one projecting actuator suitable for moving the movable grill between the open position and the closed position.
4. The adjustable air vent of claim 1, wherein the movable grill and the at least one projecting actuator are integrally molded from a plastic material.
9. A snowmobile, comprising:

a engine for driving the snowmobile;

an air path from an exterior of the snowmobile to an engine compartment; and

an adjustable air vent mounted in the air path, the adjustable air vent comprising:

a stationary grill adapted to be mounted to the

Appeal No. 2004-1016
Application No. 10/174,567

vehicle, the stationary grill having at least one air aperture and an engaging surface; and

a movable grill adapted to the movably mounted with respect to the stationary grill, the movable grill having at least one air aperture and an engaging surface adapted to engage the engaging surface of the stationary grill, the movable grill movable with respect to the stationary grill from an open position, where the at least one aperture of the stationary grill is aligned with the at least one aperture of the moveable grill to allow air to flow therethrough, to a closed position, where the at least one aperture of the stationary grill is not aligned with the at least one aperture of the movable grill to reduce the flow of air through the vent, the movable grill including at least one projecting actuator suitable for moving the movable grill between the open position and the closed position.

PRIOR ART

In support of his or her rejections, the examiner relies on the following prior art references:

Dunlap	1,521,362	Dec. 30, 1924
Allred	4,676,145	Jun. 30, 1987
Inagawa et al. (Inagawa)	5,251,718	Oct. 12, 1993

REJECTION

Claims 1 through 3, 5 and 6 stand rejected under 35 U.S.C. § 102(b) as anticipated by the disclosure of Dunlap. Claims 4 and 7 stand rejected under 35 U.S.C. § 103 as unpatentable over

Appeal No. 2004-1016
Application No. 10/174,567

the combined disclosures of Dunlap and Allred.¹ Claims 8 through 15 stand rejected under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Dunlap, Allred and Inagawa.

OPINION

We have carefully reviewed the claims, specification, applied prior art, including all of the arguments and evidence advanced by both the examiner and the appellants in support of their respective positions. This review has led us to conclude that only the examiner's rejections of claims 4, 7, 8, 12 and 15 are not well founded. Accordingly, we affirm the examiner's rejections of claims 1 through 3, 5, 6, 9 through 11, 13 and 14 for the factual findings and conclusions set forth in the Answer. We add the following primarily for emphasis and completeness.

ANTICIPATION

An anticipation under Section 102 is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of a claimed invention. ***See In re Spada***, 911 F.2d 705, 708, 15 USPQ2d 1655,

¹ The examiner inadvertently stated in the Answer that claims 4 and 5 were rejected under 35 U.S.C. § 103 as unpatentable over the combined teachings of Dunlap and Allred. However, it is clear from the examiner's final Office action dated December 16, 2002 and the examiner's Answer that this rejection is actually directed to claims 4 and 7.

Appeal No. 2004-1016
Application No. 10/174,567

1657 (Fed. Cir. 1990); ***RCA Corp. v. Applied Digital Data Systems, Inc.***, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

The law of anticipation, however, does not require that the prior art reference teach the appellants' purpose disclosed in the specification, but only that the claims on appeal "read on" something disclosed in the prior art reference. ***See Kalman v. Kimberly-Clark Corp.***, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983).

As evidence of anticipation of the subject matter defined by claims 1 through 3, 5 and 6 under 35 U.S.C. § 102(b), the examiner relies on the disclosure of Dunlap. The appellants do not dispute the examiner's finding that Dunlap teaches an adjustable air vent for a vehicle having a stationary grill, a movable grill and at least one projecting actuator as required by claims 1 and 2. See the Brief, pages 10-11. The appellants only argue that Dunlap does not teach the movable grill including the projecting actuator as recited in claim 1. ***Id.*** In other words, the appellants contend that Dunlap does not indicate that a handle 44 corresponding to the claimed projecting actuator is part of a shuttle plate 18 which corresponds to the claimed movable grill. ***Id.*** According to the appellants (the Brief, page 11):

Appeal No. 2004-1016
Application No. 10/174,567

Webster's Dictionary defines "include" as to take in or comprise as part of a whole, to contain between or within. Webster's Dictionary further defines "include" to mean to contain within as part of a whole, suggesting the containment of something as constituent, component, or subordinate part of a larger whole.

We are not persuaded by this argument. The appellants may be their own lexicographer and may define the claimed movable grill as a shuttle plate 18 *per se* or a combination of a shuttle plate 18 and a handle 14 (movable grill including a projecting actuator). However, this is merely a matter of semantics. That is, the claims on appeal, by virtue of selecting one definition over another, do not distinguish the structure of the claimed adjustable air vent from that of Dunlap's adjustable air vent in that they both require a handle (a projecting actuator) to be attached to a shuttle plate (a moveable grill).

The appellants separately argue that the limitations of claims 3, 5 and 6 are not taught in Dunlap. We are not persuaded by this argument for the findings of fact set forth at page 3, 4, 7 and 8 of the Answer. We adopt the examiner's factual findings set forth in the Answer as our own.

It follows that Dunlap teaches each and every limitation of claims 1 through 3, 5 and 6 within the meaning of 35 U.S.C. § 102(b). Hence, we affirm the examiner's decision rejecting claims 1 through 3, 5 and 6 under 35 U.S.C. § 102(b).

OBVIOUSNESS

The obviousness of an invention cannot be established by combining the teachings of the prior art references absent some teaching, suggestion or incentive supporting the combination.

See ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d

1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). This does not

mean that the prior art references must specifically suggest

making the combination. ***See B.F. Goodrich Co. V. Aircraft***

Braking Systems Corp., 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318

(Fed. Cir. 1996); ***In re Nilssen***, 851 F.2d 1401, 1403, 7 USPQ2d

1500, 1502 (Fed. Cir. 1988). Rather, the test for obviousness is

what the combined teachings of the prior art references would

have suggested to those of ordinary skill in the art. ***See In re***

Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991);

In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

As evidence of obviousness of the subject matter defined by claims 4 and 7 under 35 U.S.C. § 103, the examiner relies on the combined teachings of Dunlap and Allred. The disclosure of Dunlap is discussed above. The examiner acknowledges that Dunlap does not disclose that "the movable grill and the at least one projecting actuator are integrally molded from a plastic material" as required by claim 4.

To remedy this deficiency, the examiner refers to the disclosure of Allred. Allred teaches a ventilating device for building foundation comprising a mounting plate 16 corresponding to the claimed stationary grill, an operating plate 20 corresponding to the claimed movable grill and a knob 38 corresponding to the claimed projecting actuator. According to the examiner (Answer, page 5), Allred teaches that the operating plate and knob can be integrally molded from a plastic material. The examiner then concludes (*Id.*) that

At the time of the invention, it would have been obvious to a person of ordinary skill in this art to integrally mold the projecting actuator to the movable grill in Dunlap in view of the teachings of Allred.

In other words, it is the examiner's position that the combined teachings of Dunlap and Allred would have motivated one of ordinary skill in the art to employ the operating plate and knob integrally molded from a plastic material for a building ventilation system as the shuttle and the handle of Dunlap's automobile radiator system. See the Answer, pages 9 and 10. We do not agree.

Dunlap is directed to an improvement in automobile radiator shuttles in which it employs a particular handle (a projecting actuator) to control the flow of air to a radiator from the interior of an automobile. See column 1, lines 1-21. Although

Appeal No. 2004-1016
Application No. 10/174,567

Allred may teach an operating plate and a knob integrally molded from a plastic material for a building ventilation system, it does not teach or suggest employing such plate and knob for Dunlap's intended purpose, i.e., controlling the flow of air to a radiator from the interior of an automobile. Nor does Allred teach or suggest that its integrally molded plate and knob useful for a building ventilation system are equally useful for an automobile environment. On this record, the examiner simply has not convincingly explained why would one of ordinary skill in the art be lured to employ the integrally molded plate and knob taught in Allred in Dunlap's automobile, given the inability to control the flow of air to a radiator from the interior of the automobile during the operation of the automobile and given the space and temperature constraints between a radiator and an automobile bumper impeding the use of the integrally molded plate and knob of the type described in Allred. It follows that the examiner's decision rejecting claims 4 and 7 under 35 U.S.C. § 103 is reversed.

As evidence of obviousness of the subject matter defined by claims 8 through 15 under 35 U.S.C. § 103, the examiner relies on the combined disclosures of Dunlap, Allred and Inagawa. We initially reverse the examiner's rejection of claims 8, 12 and 15

for the reasons indicated above. Inagawa does not remedy the deficiencies indicated **supra**.

However, we concur with the examiner that Dunlap and Inagawa as whole would have rendered the subject matter of claims 9 through 11 and 13, and 14 obvious to one of ordinary skill in the art within the meaning of 35 U.S.C. § 103.² As found by the examiner (Answer, page 5), Inagawa teaches that it is well known for a snowmobile to employ an air vent. See also columns 5 and 6. The snowmobile air vent, like an automobile air vent, is used to draw air to cool its radiator. See column 5, lines 65-67. Although Inagawa does not indicate that its air vent corresponds to the claimed adjustable air vent, Dunlap teaches an automobile adjustable air vent corresponding to those recited in claims 9 through 11, 13 and 14 as indicated **supra** and in the Answer. Dunlap teaches not only using the automobile adjustable air vent to control the flow of air to a radiator, but also obtaining various advantages by using the adjustable air vent, including the adjustment of the flow of air to a radiator from the interior of a vehicle during its operation, as indicated **supra** and in the Answer.

² It is readily apparent from the Answer that Allred is relied on to show the limitations of claims 4, 7, 8, 12 and 15.

Given the advantages of the adjustable air vent described in Dunlap, we concur with the examiner that one of ordinary skill in the art would have been led to employ such adjustable air vent in the snowmobile of the type described in Inagawa, with a reasonable expectation of successfully cooling the radiator of Inagawa's snowmobile. It follows that the examiner's decision rejecting claims 9 through 11, 13 and 14 under 35 U.S.C. § 103 is affirmed.

CONCLUSION

In summary,

1. The examiner's Section 102 rejection of claims 1 through 3, 5 and 6 as anticipated by the disclosure of Dunlap is affirmed;
1. The examiner's Section 103 rejection of claims 4 and 7 as unpatentable over the combined disclosures of Dunlap and Allred is reversed;
3. The examiner's Section 103 rejection of claims 8, 12 and 15 as unpatentable over the combined disclosures of Dunlap, Allred and Inagawa is reversed; and
4. The examiner's Section 103 rejection of claims 9 through 11, 13 and 14 as unpatentable over the combined disclosures of Dunlap, Allred and Inagawa is affirmed.

Appeal No. 2004-1016
Application No. 10/174,567

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART

CHUNG K. PAK)	
Administrative Patent Judge)	
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TERRY J. OWENS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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JEFFREY T. SMITH)	
Administrative Patent Judge)	

CKP:jlb

Appeal No. 2004-1016
Application No. 10/174,567

Pillsbury Winthrop LLP
Intellectual Property Group
1600 Tysons Boulevard
McLean, VA 22102